

REMARKS

In response to the Office Action dated October 23, 2003, claims 20, 22, 23 and 31, 33 and 34 have been canceled and claims 1, 10, 13, 27, 36 and 37 have been amended. Claims 1-19, 21, 24-30, 32 and 35-37 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 23 and 24 under 35 U.S.C. 112, second paragraph, as allegedly failing to be indefinite.

In response, the Applicant has canceled claims 23 and 24 to overcome this rejection.

The Office Action rejected claims 13-18, 20, 22, 24-26, 28-29, 31, 33 and 35 under 35 U.S.C. § 101, as being directed to non-statutory subject matter.

The Applicant respectfully traverses this rejection. However, in an effort to expedite the prosecution of this case, the Applicant has amended the claims as suggested by the Examiner to overcome the rejection.

The Office Action rejected claims 1-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dedrick (U.S. Patent No. 5,724,521).

The Applicant respectfully traverse these rejections based on the amendments to the claims and the arguments below.

All of the independent claims (claims 1, 10, 13, 27, 36 and 37) now include automatically resizing the advertisement corresponding to an advertiser with the **greatest price to fit** within a publication space on the page **and** automatically resizing at least one of existing content or dynamic content to fit within available space on the page near the publication space.

In contrast, the Dedrick reference does not disclose all of these this features. For example, Dedrick merely discloses "[A] method and apparatus for providing electronic advertisements to end users in a consumer best-fit pricing manner..." that includes "...an index database, a user profile database, and a consumer scale matching process." Although Dedrick discloses comparing "...the characteristics of the individual end users with a consumer scale associated with the electronic advertisement...", clearly, **nowhere** in Dedrick is there a disclosure of all of the Applicant's claimed elements, as amended.

Namely, Dedrick does **not** disclose the Applicant's automatically resizing the placed advertisement to fit within a publication space on the page **and** automatically resizing at least one of existing content or dynamic content to fit within available space on the page near the publication space. In addition, Dedrick does not disclose the Applicant's

automatically resizing the content and the advertisement corresponding to the advertiser with the offer with the greater price to fit within a publication space defined by the advertiser.

Since Dedrick is missing at least one material limitation of the Applicants' claimed invention, it cannot legally render the claims obvious. It is well settled that when the Examiner evaluates a claim for determining obviousness, all limitations of the claim must be evaluated. If the combination of references do not produce are missing limitations of the Applicant's claimed invention then a prima facie showing of obviousness does cannot exist. In Re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987). In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As such, Therefore, a prima facie case of obviousness cannot be established, and hence, the rejections must be withdrawn. ACS Hospital Systems, Inc. v. Montefiore Hospital (MPEP 2143.01).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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